

Appl. No. 09/735,572
Amdt. Dated July 7, 2006
Reply to Office Action of April 11, 2006

REMARKS

This Amendment is in response to the Office Action mailed November 1, 2005. In the Office Action, claims 1-9, 14-22 and 27-30 were rejected under 35 U.S.C. § 103. Applicants respectfully traverse the rejections in their entirety. Reconsideration in light of the remarks made herein is respectfully requested.

Rejections Under 35 U.S.C. §103

I. CLAIMS 1-4, 8-9 AND 27-30

Claims 1-4, 8-9 and 27-30 were rejected under 35 U.S.C. §103(a) as being unpatentable over Sako (U.S. Patent No. 5,689,575) in view of Broderick (U.S. Patent No. 6,746,120). Applicants respectfully traverse the rejection because a *prima facie* case of obviousness has not been established.

As the Examiner is aware, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. *See MPEP §2143; see also In Re Fine, 873 F. 2d 1071, 5 U.S.P.Q.2D 1596 (Fed. Cir. 1988).* Herein, the combined teachings of the cited references fail to describe or suggest all the claim limitations.

With respect to claims 1 and 27, Applicants respectfully submit that neither Sako nor Broderick, alone or in combination, describes or suggests an operation and/or software for *suggesting a color for subsequent user selection based on the generated histogram to serve as the color for a template design used to display the source image*, as recited in claim 1. *Emphasis added.*

First, the Office Action alleges that Sako discloses “indicates a color histogram for a template design used to display (4) a source image” (Office Action, page 2). Sako merely

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discloses dividing the template histogram value by the resulting histogram value to obtain a new ratio histogram which indicates which colors in the input image are likely to belong to the mouth (Sako, col. 6, lines 1-23), indicating that the histogram displays pixels of the desired portion, the mouth. In contrast, the generated histogram of the claimed invention is used to suggest a color (1) for subsequent user selection and (2) to serve as the color for a template design used to display the source image.

Moreover, the Office Action states "Sako fails to teach suggesting a color for subsequent user selection for the template design" (Office Action, page 3). Applicants agree. However, the Office Action alleges that Broderick discloses this limitation. Applicants respectfully disagree with this allegation. Broderick merely discloses "receiving a request from the user indicating selection of at least one of the eye templates, providing the user with a plurality of available colors for incorporation into a portion of the selected template" (Broderick, col. 3, lines 18-31), indicating that the colors provided to the user are merely those available rather than suggesting a color for subsequent user selection based on the generated histogram, as recited in claim 1.

Furthermore, neither Sako nor Broderick discusses color selection by the user for a "template design" for the source image being based on a generated histogram. Sako merely discloses "template histograms of the facial part which is to be identified to provide an output BP signal which indicates the degree of possibility that the pixel is in the facial area" (Sako, col. 6, lines 1-23). Broderick merely discloses "customized template images showing the shape, color and surrounding features of a user's actual eye" (Broderick, col. 2, lines 30-32). In contrast, based on the generated histogram, the claimed invention provides color suggestions for templates used for presentations.

Hence, withdrawal of the §103(a) rejection as applied to independent claims 1 and 27 is respectfully requested.

In addition, based on the dependency of claims 2-4, 8-9 and 28-30 on independent claims 1 and 27, believed by Applicants to be in condition for allowance, no further discussion as to the grounds for traverse is warranted. Applicants reserve the right to separately argue the merits of

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allowability for these claims if an Appeal is necessary. Withdrawal of the §103(a) rejection as applied to claims 2-4, 8-9 and 28-30 is respectfully requested.

II. CLAIM 5

Claim 5 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Sako and Broderick and in view of Takayama (U.S. Patent No. 6,222,570). Applicants respectfully traverse the rejection because a *prima facie* case of obviousness has not been established.

First, as above, neither Sako nor Broderick teach the limitation of “suggesting a color for subsequent user selection based on the generated histogram to serve as the color for a template design used to display the source image” as set forth in claim 1. Moreover, Takayama merely discloses a template image 57, constituted by a background image (Takayama, col. 7, lines 11-12), provided with a frame image 58 of a light gray color for the purpose of avoiding the occurrence of dark or blank stripes (Takayama, col. 11, lines 41-45). This indicates that the colors in the template image and frame image are static.

Second, the Office Action alleges that Sako and Broderick fail to disclose applying a color is selected from a group consisting of framing, mat, background, and foreground portions of the template design (Office Action, page 4). Applicants agree. However, the Office Action contends that Takayama discloses this limitation because it “teaches applying color to the frame(ing), or background portions of the template design” (Office Action, page 4). Applicants respectfully disagree with this contention.

Takayama merely discloses a template image 57 provided with a frame image 58 of a light gray color, wherein the frame image segments 58a are colored in gray. The frame image 58 may be so colored that its density is gradually changed from the color of the background image 32 to that of the insertion region 34 in a continuous manner, or is gradually changed from the color of the background image 32 to gray and from gray to the color of the insertion region 34 (Takayama, col. 11, lines 50-67). Therefore, Takayama merely disclose coloring images as part of a thermal printing method, whereby the color is neither *suggested* nor applied to portions of

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the template based on a *selection*. Thus, Takayama does not disclose the limitations set forth in claim 5.

Moreover, based on the allowability of claim 5 on its merit and its dependency on independent claim 1, believed by Applicants to be in condition for allowance, no further discussion as to the grounds of traverse are warranted. Applicants reserve the right to present such arguments if an Appeal is warranted.

Hence, withdrawal of the §103(a) rejection as applied to claim 5 is respectfully requested.

III. CLAIM 7

Claim 7 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Sako and Broderick in view of Sparks (U.S. Patent No. 6,167,382). Applicants respectfully traverse the rejection because a *prima facie* case of obviousness has not been established.

First, as discussed above, neither Sako nor Broderick teach the limitation of “suggesting a color for subsequent user selection based on the generated histogram to serve as the color for a template design used to display the source image” as set forth in claim 1. Moreover, Sparks does not provide such teachings. Sparks merely discloses successive computer screens presented to a client designing a merchandizing kit (Sparks, col. 21, lines 63-65). The kits comprise of menu templates, page slots and slot inserts (Sparks, col. 22, lines 8-25), indicating that the user selects among predetermined templates as opposed to suggested colors based on the generated histogram.

Second, the Office Action alleges that Sako and Broderick fail to teach receiving compensation for providing the template design (Office Action, page 5). Applicants agree. However, the Office Action contends that Sparks discloses this limitation because the template slots are equivalent to the template design (Office Action, page 5). Applicants respectfully disagree with this contention.

In Figures 44-49, Sparks merely illustrates (1) a menu template consisting of slots, (2) a client is prompted for a price to be inserted into the slots, (3) a confirmation of the price selected,

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and (4) an order information page (Sparks, col. 22, lines 8-25), indicating that the template slots are merely price inserts, rather than the "color template design" comprising of color suggestions, based on the generated histogram, for presentation templates. Thus, Sparks does not disclose "receiving compensation for providing the color template design", as recited in claim 7.

Moreover, based on the allowability of claim 7 on its merit and its dependency on independent claim 1, believed by Applicants to be in condition for allowance, no further discussion as to the grounds of traverse are warranted. Applicants reserve the right to present such arguments if an Appeal is warranted.

Hence, withdrawal of the §103(a) rejection as applied to claim 7 is respectfully requested.

IV. CLAIMS 14-15 AND 17

Claims 14-15 and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sako, Wang, and Broderick and in view of Tushie (U.S. Patent No. 6,202,155). Applicants respectfully traverse the rejection because a *prima facie* case of obviousness has not been established, given that none of the cited references, alone or in combination, teach or suggest all of the claimed limitations.

For instance, with respect to the rejection of claim 14, it is noted that the Office Action states Sako teaches "suggesting a color based on the generated histogram to serve as the color for a template design used to display (4) the source image" (Office Action, page 6). However, page 7 of the Office Action states that "Sako fails to teach suggesting a color for subsequent user selection for the template design" (Office Action, page 7). Applicants believe that these statements contradict each other and respectfully request the Examiner to reconsider, and if need be, reissue a new Office Action for clarification purposes.

Furthermore, the Office Action states that the source image is equivalent to the input image derived from the camera (Office Action, page 6), indicating that the ratio histogram is generated for colors associated with the source image, and not the template design as set forth in claim 14.

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Also, the Office Action further states Wang discloses a processor generating a histogram for an image and indicating a color histogram for a template design used to display the image and display a template and the color for the template design (Office Action, page 6). Applicants respectfully disagree.

Wang merely discloses a color histogram representing the frequency distribution of colors by their hue and saturation levels for processing image data (Wang, col. 11, lines 32-59; col. 12, lines 36-62 and col. 15, line 52 to col. 16, line 3). Wang is directed to a mechanism for searching graphic images, and does not describe or suggest any operations or software for suggesting color for a template design as claimed.

For Wang, a color histogram for each image is contained within a color histogram side information file, which may be analyzed (low level analysis) to extract various statistical abstractions from each image that can be related to semantically meaningful abstractions that a user may use to describe the image. Wang describes an example of searching for a "blue sky" and enabling the user to locate images with a blue sky (Wang, col. 17, lines 35-52).

In contrast, the claimed invention is directed *suggesting a color* for subsequent user selection based on the generated histogram *to serve as the color for a template design used to display the source image. Emphasis added.* The search system of Wang is adapted for search purposes, and is not configured to provide any suggestion of template design colors, even when combined with the teachings of Sako. Rather, the search system of Wang provides a mechanism searching for graphic images based on semantically meaningful abstractions including those abstractions mentioning particular colors as noted above.

Moreover, based on the dependency of claims 15 and 17 on independent claim 14, believed by Applicants to be in condition for allowance, no further discussion as to the grounds of traverse are warranted. Applicants reserve the right to present such arguments if an Appeal is warranted.

Withdrawal of the §103(a) rejection as applied to independent claim 14 and those claims dependent thereon is respectfully requested.

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V. CLAIMS 16 AND 21-22

There is no indication in the Office Action of any rejection applied to claims 16 and 21-22. Since the recitation of rejected claims on page 6 (claims 14-15, and 17) of the Office Action differs from the claims stated in the arguments that follow (claims 14, 16, 21-22), Applicants are unsure of the proper interpretation of this rejection. Previously, Applicants advised the Examiner that the recitation of rejected claims on page 6 of the Office Action differs from the claims recited in the arguments themselves. To date, the Examiner still has not addressed this improper rejection. Therefore, Applicants respectfully request the Examiner to provide an explanation of the status of these claims in a subsequent Office Action, if needed. Based on the dependency of claims 16 and 21-22 on independent claim 14, believed by Applicants to be in condition for allowance, no further discussion as to the grounds for traverse should be warranted. Applicants reserve the right to present such arguments if an Appeal is warranted.

Hence, withdrawal of the §103(a) rejection as applied to claims 16, 21 and 22 is respectfully requested.

VI. CLAIMS 18 AND 20

Claim 18 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Sako, Wang, Broderick and Tushie and Takayama. In addition, Claim 20 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Sako, Wang, Broderick and Tushie in view of Sparks. Applicants respectfully traverse the rejection because a *prima facie* case of obviousness has not been established, given that none of the cited references, alone or in combination, teach or suggest all of the claimed limitations.

First, Applicants incorporate the arguments set forth above: None of the cited references disclose (1) “suggest a color based on the generated histogram to serve as the color for a template design used to display the source image”, as recited in claim 14; or (2) a template design. Furthermore, Sparks does not disclose “receiving compensation for providing the color template design”, as recited in claim 20, since template slots are merely price inserts, rather than

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the "color template design" comprising of color suggestions, based on the generated histogram, for presentation templates.

Second, based on the dependency of claims 18 and 20 on independent claim 14, believed by Applicants to be in condition for allowance, no further discussion as to the grounds for traverse is warranted. Applicants reserve the right to present such arguments if an Appeal is warranted.

Hence, withdrawal of the §103(a) rejection as applied to claims 18 and 20 is respectfully requested.

VII. CLAIMS 6 AND 19

Claims 6 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Sako and Broderick in view of Jammes (U.S. Published Application No. 2003/0167213). In addition, claim 19 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Sako, Wang, Broderick, and Tushie in view of Jammes. Applicants respectfully traverse the rejection because a *prima facie* case of obviousness has not been established, given that none of the cited references, alone or in combination, teach or suggest all of the claimed limitations.

First, Applicants incorporate the arguments set forth above: None of the cited references disclose (1) "suggest a color based on the generated histogram to serve as the color for a template design used to display the source image", as recited in claim 14; and (2) a template design.

Second, based on the dependency of claims 6 and 19 on independent claims 1 and 14, believed by Applicants to be in condition for allowance as noted above, no further discussion as to the grounds for traverse is warranted. Applicants reserve the right to present such arguments if an Appeal is warranted.

Hence, withdrawal of the §103(a) rejection as applied to claims 6 and 19 is respectfully requested.

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Conclusion

Applicants respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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